

## **REMARKS**

### **1. The Amendments and the Support Therefor**

No claims have been canceled or added, and claims 1, 8, and 15 have been amended to leave claims 1-6, 8-11, 15-18, and 20-25 in the application. No new matter has been added by the amendments, which are supported particularly by FIG. 1.

### **2. Information Disclosure Statement (Form PTO-1449)**

Please note that an Information Disclosure Statement (IDS), including a form 1449, was filed on 18 December 2003. (A duplicate copy of the PTO-1449 accompanies this Response for the Examiner's convenience.) The IDS has not been acknowledged in the Office Action. Please verify receipt of the IDS in any future communications. If the cited references are not present in the file, please contact the undersigned attorney, who will forward copies.

### **3. Section 2 of the Office Action: Rejection of Claim 1 under 35 USC §112(2)**

Claim 1 stands rejected since the term "the entirety" is regarded as lacking antecedent basis. Kindly reconsider. The rejection should be withdrawn owing to the precepts noted in MPEP 2173.05(e) ("Lack of Antecedent Basis"):

[T]he failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid"). Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter").

It is submitted that claim 1 is in accordance with 35 USC §112(2) since "the entirety" is plainly an inherent characteristic of the backbox, and its meaning is readily ascertainable by an ordinarily skilled artisan within a reasonable degree of certainty (MPEP 2173.02). Any ordinary artisan would comprehend that "the entirety" of the backbox means the entire backbox.

**4. Sections 3-4 of the Office Action: Rejection of Claims under 35 USC §102 or 35 USC §103(a) in view of U.S. Patent 3,989,909 to Hodsdon et al.**

The claims, as amended, clearly differentiate the invention from that of *Hodsdon et al.* *Hodsdon et al.* illustrates a radio having a backbox (FIG. 1) with a grill 14 mounted across its opening, the grill 14 being depicted in greater detail in FIGS. 2 and 3. Looking to FIG. 3, the grill 14 is bounded by flanges which snap onto the radio backbox, and protruding pegs 19 on the grill 14 receive a sound baffle sheet 25 (shown in FIGS. 4 and 5). As depicted in FIG. 6, the sound baffle sheet 25 is mounted between the grill 14 and the speaker 31.

Looking to independent claim 1, several differences from *Hodsdon et al.* are recited, and these differences are nowhere suggested by any art of record:

- (1) Claim 1 has been amended to recite that the entirety of the backbox "is situated above and within the boundaries of the interior surface of the grill" to better indicate that the backbox takes a configuration as illustrated in FIG. 1 of the present application, i.e., the entirety of the backbox is laterally bounded by the grill, and the backbox does not have any portions which extend laterally above the boundary of the grill. As noted in the specification of this application, the claimed speaker is intended to fit into a ceiling (or other surface) in place of a ceiling or other tile, without occupying significantly more space than an ordinary tile and while presenting a front/exposed surface with a regular/uniform appearance, whereby the speaker does not have an appearance which unduly stands out with respect to the surrounding tiles; and the speaker also has an inexpensive construction which is easily manufactured, installed, and maintained. Consider from FIG. 1 of the present application that if portions of the backbox extended laterally outwardly above the boundary of the grill, the speaker would not be able to be readily inserted in a ceiling tile cavity. It cannot fairly be said that there is any motivation in any art of record to modify *Hodsdon et al.* to attain the claimed arrangement, since there would be no apparent benefit to such a modification (and similarly, it cannot be said that *Hodsdon et al.* offers any motivation to modify any other art of record to meet the claimed arrangement).

- (2) Note that claim 1 also recites that the sound baffle sheet(s) extend between the speaker and the peripheral edge of the backbox. As can be seen best in FIG. 6, *Hodsdon et al.*'s sound baffle sheet rests between the speaker and the grill, and does not extend from the speaker to the peripheral edge of the backbox.

Similarly, independent claim 8 recites several differences from *Hodsdon et al.* which are nowhere suggested by any art of record:

- (1) Similarly to claim 1, the backbox is said to be laterally bounded by its peripheral edge, and the grill is crimped about the peripheral edge. As noted previously, *Hodsdon et al.* is not laterally bounded by its peripheral edge: FIG. 1 plainly depicts portions of the backbox/radio extending laterally (more precisely above and below) the peripheral edge upon which the grill 14 is fit. Again, the claimed arrangement allows the claimed speaker to be readily inserted in place of a tile, whereas *Hodsdon* plainly does not, and there is no motivation to modify *Hodsdon* to attain the recited arrangement.
- (2) Also note that claim 8 recites that the grill is crimped about the peripheral edge of the backbox, and *Hodsdon et al.* does not utilize this arrangement. Note that "crimping" has a well-understood meaning of pinching a structure about another, as illustrated by the following online dictionary entries:

- Merriam-Webster Online Dictionary (<http://www.m-w.com/>)  
to pinch or press together (as the margins of a pie crust) in order to seal
- Encarta Online Dictionary (<http://encarta.msn.com/>)  
fold or press together: to fold or press the ends or edges of something together
- Cambridge Online Dictionary (<http://dictionary.cambridge.org/>)  
to press cloth, paper, etc. into small folds along its edges, or to press hair into a series of folds using a heated instrument
- The American Heritage Online Dictionary (<http://www.bartleby.com/am/>)  
To press or pinch into small regular folds or ridges: crimp a pie crust

Note from FIGS. 3 and 6 of *Hodsdon et al.* that the grill is formed with thick peripheral flanges which are simply structurally incapable of being crimped.

Independent claim 15 is submitted to be allowable for the same reasons as those noted for claim 8 above.

No art of record is believed to illustrate the claimed features, or to suggest that a speaker such as the one claimed would be beneficially constructed; nor does any other art of record teach or suggest a speaker which may be readily used in place of a tile, and which has the advantages of the claimed speaker. Allowance of the claims is therefore requested.

**5. In Closing**

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



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